



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,914	11/27/2001	Satoru Okada	723-1222	7392

27562 7590 02/04/2005

NIXON & VANDERHYE, P.C.
1100 N. GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201

EXAMINER

PHAM, TUAN

ART UNIT	PAPER NUMBER
----------	--------------

2643

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,914

Applicant(s)

OKADA ET AL.

Examiner

TUAN A PHAM

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/14/04, 3/27/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by Nagasawa (U.S. Patent No.: 6,782,281).

Regarding claim 20, Nagasawa teaches an electronic apparatus, having a game function and a phone function (see figure 6), comprising:

a pause key to initiate pausing (i.e., suspending) of a game process in execution, and a pausing mechanism which pauses a game process in execution upon one of the operation of the pause key and occurrence of incoming phone call (see figure 1, figure 9, suspend the game S25, key 5a, col.6, ln.1-37).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasawa (U.S. Patent No.: 6,782,281) in view of Chen et al. (U.S. Patent No.: 6,748,404), hereinafter, "Chen").

Regarding claims 1, 7, 10, and 11, Nagasawa teaches a method, program, storage, and an electronic apparatus having a game function and a phone function (see figure 6), comprising:

an interruption key to initiate an interruption of a game process in execution (see figure 1B, figure 9, key 5a, col.6, ln.13-20);

an interrupting mechanism, which interrupts the game process when a setting of the first register indicates the first predetermined value (see figure 1B, key 5a, col.6, ln.13-20);

a detector which detects an incoming phone call (see figure 9, col.6, ln.13-20);
and

a setting mechanism, which sets the first predetermined value into the first register in response to a detection of the incoming phone call (see figure 9, col.6, ln.13-20).

It should be noticed that Nagasawa does not clearly show a first register to which a first predetermined value is set in response to operation of the key. However, Chen teaches such features (see figure 2, register 11-15, col.2, ln.15-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a first register to which a first predetermined value is set in response to operation of the key, as taught by Chen, into view of Nagasawa in order to edit the desire data in the register as suggested by Chen at col.1, ln.24-52.

Regarding claims 2 and 8, Nagasawa teaches the electronic apparatus and method, further comprising a storing mechanism which stores current game data into a memory when the first register indicates the first predetermined value (see figure 6, controller pocket game 28, col.5, ln.15-22, it is inherently to have a memory for storing the game program).

Regarding claim 3, Nagasawa teaches the electronic apparatus further comprising a determination mechanism which determines whether the game process is in execution or not, wherein the setting mechanism set the first predetermined value into the first register when the game process is in execution and the detector detects an incoming phone call (see figure 1B, figure 9, key 5A, col.6, ln.1-37).

Regarding claim 4, Nagasawa teaches the electronic apparatus further comprising: a restart key to initiate a resumption of the game process; a second register to which a second predetermined value is set in response to operation of the restart key; and restart mechanism which resumes the game process when setting of the second register indicates the second predetermined value (see figure 9, key 5B, restart the game S34, col.6, ln.21-27, Chen teach plurality of register).

Regarding claims 5 and 9, Nagasawa teaches the electronic apparatus and method further comprising: a display which displays a game screen; and a modifying mechanism which modifier a tone of the game screen in response to a detection of the incoming phone call (see figure 6, first display 4, speaker 23, col.5, ln.3-50).

Regarding claim 6, Nagasawa teaches the electronic apparatus further comprising: wherein the game process is executed according to a program downloaded from an outside source by the phone function (see figure 6, controller for game pocket, col.5, ln.15-22).

Regarding claims 12, 13, and 14, Nagasawa teaches the method, program, and storage wherein the electronic apparatus further includes the restart key, further comprising the step of: pausing (i.e., suspending) the game process when the

Art Unit: 2643

operation data is set to the predetermined value; continuing to pause the game process while the restart key has not been operated, and resuming the execution of the game process upon operation of the restart key (see figure 1, figure 9, restart key 5B, col.6, ln.3-35).

Regarding claim 15, Nagasawa teaches the electronic apparatus wherein the interruption of the game process in execution further comprises: a pausing (i.e., suspending) mechanism which pauses the game process in execution and which maintains the pause of the game process until the game process execution is resumed (see figure 9, suspend the game S25, col.6, ln.1-20).

Regarding claim 16, Nagasawa teaches the electronic apparatus wherein resuming the game process further comprises: a clearing mechanism (i.e., restart function) which removes the first predetermined value from the first register and removes the second predetermined value from the second register (see figure 9, key 5B, col.6, ln.3-38).

Regarding claims 17, 18, and 19, Nagasawa teaches the method, program, and storage, wherein resuming the execution of the game process further comprises the step of: setting the operation data to a value other than the predetermined value (see col.2, ln.17-27).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In order to expedite the prosecution of this application, the applicants are also requested to consider the following references. Although Hochstein et al. (U.S. Patent No. Re.36,574), Takahashi et al. (Pub. No. : US 2002/0094069), Coleman et al. (Pub. No.:US 2003/0060258), and Watanabe (Pub. No.: US 2001/0018364) are not applied into this Office Action; they are also called to Applicants attention. They may be used in future Office Action(s). These references are also concerned for supporting the system and method for gaming with simulation of telephone for player interaction.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (703) 305-4987. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz can be reached on (703) 305-4708 and

IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to: (703) 872-9306


Art Unit: 2643

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2643
February 2, 2005
Examiner

Tuan Pham


CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600